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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,027	05/24/2000	Ron Cohen	50325-0125	4795

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EXAMINER	
NGUYEN, QUANG N	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/578,027	COHEN ET AL.	
	Examiner	Art Unit	
	Quang N. Nguyen	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detail Action

1. This Office Action is in response to the Communication filed on 07/19/2004. Claim 22 has been amended. Claims 1-30 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-2, 4-17, 19-25, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beranek et al. (US 6,226,642), herein after referred as Beranek, in view of Kavner (US 6,366,947).

4. As per claims 1, 11-16, and 29-30, Beranek teaches a system and method of optimizing retrieval of electronic documents, comprising:

receiving a first electronic document *(the caching proxy receives the Web document from the server)* (Beranek, C3: L19-20 and C10: L21-23);

creating and storing a modified copy of the first electronic document in which a substitution is made for each corresponding symbolic reference *(the caching proxy 225 is used to add links, to modify links, to add or modify scripts, etc.)*; and delivering the modified copy of the electronic document in response to all subsequent requests for the first electronic document *(after the Web page has been modified, the modified page is preferably stored back in the cache in order that it maybe reused if and when the user desires to revisit the page at a subsequent time)* (Beranek, Fig. 7, C11: L3-11 and C12: L31-38).

However, Beranek does not explicitly teach identifying one or more symbolic references to other electronic documents within the first electronic document and determining a network address of each of the other electronic documents corresponding to each of the symbolic references.

Kavner teaches a system and method for accelerating network interaction using intelligent cacheing and intelligent fetching wherein a number of hypertext links *(i.e., symbolic references)* such as buttons, certain words or images, associated with additional information were identified by issuing the software call "GET HOST BY NAME" to the original Winsock library to retrieve the TCP/IP address of a host name from the network *(i.e., determining a network address of each of the other electronic documents corresponding to each of the symbolic references)* and storing that TCP/IP address in a local cache (Kavner, Fig. 5, C12:L44 – C13:L25 and C16: L32-58).

Since Beranek teaches that URLs in a document can be modified, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to

have Beranek determine/retrieve the network TCP/IP address for each of the symbolic references and save it locally, as taught by Kavner, since such methods were conventionally employed in the art to retrieve and store the network TCP/IP addresses corresponding to the hypertext links *(e.g., symbolic references)* in the cache mitigating the need to retrieve the network TCP/IP addresses from DNS, for cacheing and/or pre-loading hypertext links of the corresponding Web document in order to more speedily retrieve the information at a subsequent time (Kavner, C3: L31-38 and C5: L54-58).

5. As per claim 2 and 17, Beranek-Kavner teaches the invention of claim 1, but does not explicitly teach delivering an unmodified copy of the first electronic document in response to a client request for the first electronic document, concurrently while performing the steps of identifying, determining, creating and storing.

Kavner teaches sending a copy of the document *(unmodified)* in the cache concurrently while determining if a document should be updated *(modified)* (Kavner, C4: L44-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include delivering an unmodified copy of the first electronic document in response to a client request for the first electronic document, concurrently while modifying the document, as taught by Kavner, in the modified Beranek invention, because the user would get the benefit of seeing the web page immediately while the changed resources are updated in the background (Kavner, C4: L56-59).

6. As per claims 4 and 19, Beranek-Kavner teaches the invention of claim 1, further comprising storing the modified copy in cache storage of a cache server (Beranek, C12: L31-38).

7. As per claims 5 and 20, Beranek-Kavner teaches the invention of claim 4, but does not explicitly teach retrieving and storing in the cache storage, each of the other electronic documents and carrying out the steps of identifying, determining, creating and storing, and delivering for each of the other documents in the cache storage, before or at the same time as receiving one or more client requests for the other electronic documents.

Kavner teaches fetching all links associated with a page presently being viewed and storing them in the cache (Kavner, C5: L58-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the pre-fetching of links, as taught by Kavner, in the modified Beranek invention *(that automatically performs the steps of identifying, determining, creating and storing, and delivering all received documents)* because when a user eventually selects one of the links the page can be displayed immediately instead of waiting for it to be downloaded, as taught by Kavner (C5: L54-58).

8. As per claims 6 and 21, Beranek-Kavner teaches the invention of claim 1, but does not explicitly teach determining that one or more symbolic references identifies a prohibited network resource and substituting a network address of a predetermined network resource for the symbolic references to the prohibited network resource.

Kavner teaches a content filter or blocking feature that replaces content in a web page with other content, where the content can be any form of identifiable information *(i.e., prohibited network resources)* (Kavner, C19: L22-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include replacing prohibited symbolic references with predetermined content, as taught by Kavner, and using the network address replacement method described in the modified Beranek invention, because substituting predetermined content for prohibited content would prevent the user from viewing unauthorized of offensive material.

9. As per claims 7 and 22, Beranek-Kavner teaches the invention of claim 6, but does not explicitly teach the predetermined network resource being a predefined electronic document that comprises a message specifying that access to the prohibited network resource is prohibited.

"Official Notice" is taken that both the concept and advantages for providing a predefined document stating access is prohibited are well known and expected in the art *(HTTP 401/403 error messages, ad blockers)*.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have a predetermined network resource being a predefined electronic document that comprises a message specifying that access to the prohibited network resource is prohibited in the modified Beranek invention because the end user would be able to see why a page is not being displayed correctly.

10. As per claims 8-10 and 23-25, Beranek-Kavner teaches the invention of claim 1. Furthermore, Beranek-Kavner teaches the electronic document comprising an HTML document and wherein the symbolic references comprise: only embedded URL's in the HTML document; only selected URL's in the HTML document as determined according to a selection policy; or all URL's in the HTML document *(re-formatting the web page according to some given protocol or filter property)* (Beranek, C3: L19-25).

11. As per claim 28, Beranek-Kavner teaches the invention of claim 1. Furthermore, Beranek-Kavner teaches the electronic document comprising an HTML document and wherein the symbolic references comprise hostnames in embedded URL's in the HTML document and hostnames in hyperlinks in the HTML document (Beranek, C3: L25-31).

12. Claims 3, 18, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Kavner (6,366,947), as applied to claims 1 and 16 above, and further in view of Admitted Prior Art (APA).

13. As per claims 3, 18, and 26-27, Beranek discloses the claimed invention modified by Kavner as described above. However, the modified Beranek invention does not explicitly teach determining that a plurality of symbolic references identify one particular host name and substituting a different network address in each of the symbolic references that identify the particular host name, wherein each different network address is associated with one of a plurality of replicated servers.

APA teaches providing different IP addresses for successive requests for the same host name, wherein each IP address identifies one of a plurality of replicated servers in different regions (Specification, page 2, lines 1-7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a host name's different IP addresses taught by the applicant substituted for the same host name during the substation process in the modified Beranek invention because more processor power would be available on each server to deliver content, as taught by the applicant (Specification, page 1, lines 24-27).

Response to Arguments

14. In the remarks, applicant argued in substance that

(A) References (Beranek and Kavner) cannot be combined where a reference (Beranek) teaches away from their combination.

As to point (**A**), it is noted that a prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Also, it is noted that, "the test for obviousness is not whether the features of a secondary reference maybe bodily incorporated into the structure of the primary reference... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed, Cir. 1983).

(**B**) Examiner's conclusion of obviousness is based on improper hindsight reasoning.

As to point (**B**), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's

disclosure, such a reconstruction is proper." See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

15. Applicant's arguments as well as request for reconsideration filed on 07/19/2004 have been fully considered but they are not deemed to be persuasive.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LE HIEN LUU
PRIMARY EXAMINER